

REMARKS/ ARGUMENTS

The Final Office Action of February 9, 2003 has been carefully reviewed and this response addresses the Examiner's concerns.

In the specification, the amendment filed on 12/2/02 for page 7 (lines 9-19) was objected to under 35 U.S.C.112 for introducing new matter. Applicants respectfully request reconsideration based on MPEP 608.01(I). MPEP 608.01(I) states that " [i]n establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it." Claims 6, 27, 49 of the original disclosure read as follows:

6. A method according to claim 5, wherein said substrate is a solid phase composition comprising silicon, glasses, plastics, polymers, metals, ceramics or mixtures thereof

27. A method according to claim 26, wherein said substrate is a solid phase composition comprising silicon, glasses, plastics, polymers, metals, ceramics or mixtures thereof

49. A method according to claim 48, wherein said substrate is a solid phase composition comprising silicon, glasses, plastics, polymers, metals, ceramics or mixtures thereof.

Applicant respectfully asserts that the original claims support the inclusion of ceramics as substrates in the specification.

Claims 1-3, 6-7, 10-12, 14-19, 66-67 and 69-70 are pending in the application. Claims 22-65 are withdrawn from consideration.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 22-65 in a divisional application

Claim 66 is rejected based on 35 U.S.C. 112, paragraph 1. Applicants respectfully request reconsideration of Claim 66 based on the argument presented above, on MPEP 608.01(l) and original claims 6, 27, and 49.

Claims 1-2, 10, 12, 14, and 69-70 were rejected under 35 U.S.C. §102(b) as being anticipated by Hutchens et al., U.S. Patent 5,719,060. Claims 1-3, 10, 12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §102(e) as being anticipated by Nelson et al. (U.S. Patent 5,955,729). Claims 1-2, 6-7, 10-12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §102(e) as being anticipated by Siusdak et al. (U.S. Patent 6,288,390). Claims 1-2, 6-7, 10-12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Siusdak et al. (U.S. Patent 6,288,390) in view of Mian et al. (6,319,469).

Claims 1-2, 10, 12, 14, and 69-70 were rejected under 35 U.S.C. §102(b) as being anticipated by Hutchens et al., U.S. Patent 5,719,060.

Applicants respectfully traverse these rejections for the reasons presented below.

In order to better understand the differences between present invention and the Hutchens et al. patent it should be recognized that in the Applicants' invention the films are morphologically tailored to enable the applying a sample to a deposited continuous thin film by either adsorption or directly to a surface of said deposited continuous thin film without having to provide surface associated molecules to which the sample is chemical attached.

In comparison, the '060 patent (Hutchens) discloses sample presenting means utilizing surface associated molecules to effectuate the chemical attachment of sample to the sample presenting means (col. 14, lines 36-41). Applicants respectfully assert that amended Claim 1, wherein the sample is not attached to the thin film by chemical attachment to surface associated molecules, is not anticipated by the '060 patent (Hutchens) and neither are any of the dependent claims.

Claims 1-3, 10, 12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §102(e) as being anticipated by Nelson et al. (U.S. Patent 5,955,729).

Applicants respectfully traverse these rejections for the reasons presented below.

Nelson et al (U.S. Patent 5,955,729) also disclose utilizing surface associated molecules to effectuate the chemical attachment of sample to the surface. (col. 3, lines 64-66, col. 8, lines 29-33). Applicants respectfully assert that amended Claim 1, wherein the sample is not attached to the thin film by chemical attachment to surface associated molecules, is not anticipated by the '729 patent (Nelson) and neither are any of the dependent claims.

Claims 1-2, 6-7, 10-12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §102(e) as being anticipated by Siusdak et al. (U.S. Patent 6,288,390)

Applicants respectfully traverse these rejections for the reasons presented below.

In order to better understand the differences between Applicants' invention and the '390 (Siusdak) patent should be recognized that the Applicants' invention is directed to deposited films that are morphologically tailored to enable the applying a sample to the deposited continuous thin film. Siusdak et al. disclose loading a sample (analyte) onto a porous silicon

substrate. Porous silicon is obtained when a silicon wafer is chemically (wet) etched. (See c l. 9, lines 55-67, col. 12, lines 33-48; see also,

<http://www.bath.ac.uk/physics/groups/opto/psilicon.html>,

<http://ee.tamu.edu/~ryongkim/WEBdiagram/PSformation.html>, and

<http://www.eetimes.com/story/OEG20011015S0066>). Obtaining other porous semiconductors also requires wet etching. See , for example, <http://www.otm.uiuc.edu/techdetail.asp?id=21>. The substrate in the Applicants' claimed invention is not wet etched. Applicants respectfully assert that amended Claim 1, wherein the surface is not wet etched, is not anticipated by the '390 patent (Siusdak) and neither are any of the dependent claims.

Claims 1-2, 6-7, 10-12, 14, 17, 66 and 69-70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Siusdak et al. (U.S. Patent 6,288,390) in view of Mian et al. (6,319,469).

Siusdak does not disclose a method for the analysis of a sample including applying the sample to a deposited continuous thin film by either adsorption or directly to a surface of the deposited continuous thin film, wherein the surface is not wet etched. Mian does not disclose a method for the analysis of a sample including applying the sample to a deposited continuous thin film by either adsorption or directly to a surface of the deposited continuous thin film, wherein the surface is not wet etched. Siusdak when combined with Mian does not teach a method for the analysis of a sample including applying the sample to a deposited continuous thin film by either adsorption or directly to a surface of the deposited continuous thin film, wherein the surface is not wet etched.

Under a 103 rejection, a *prima facie* case of obviousness of the invention is made in view of the scope and content of the prior art. In order to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) must teach or suggest all of the claim limitations." M.P.E.P. § 2143.

Neither Siusdak nor Mian separately or in combination teach all the limitations of amended claim 1. In light thereof, Applicants respectfully traverse the 35 U.S.C. 103 rejection of the claims.

In conclusion, in view of the above remarks, Applicants respectfully request the Examiner find all claims 1-3, 6-7, 10-12, 14-19, 66-67 and 69-70 as amended allowable over the prior art and pass this case to issue.

Any required fees should be charged to Deposit Account No. 03-2410, order 11913-113.

In accordance with Section 714.01 of the M.P.E.P., the following information is presented in the event that a call may be deemed desirable by the Examiner:

ORLANDO LOPEZ (617) 854-4000

Application Serial No.: 09/739,940
Attorney Docket No. 30626-101

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Respectfully submitted,

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